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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/990,326

11/23/2001

Anthony Derosé

PT-1475000

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09/20/2006

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EXAMINER

SILBERMANN, JOANNE

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,326	DEROSE, ANTHONY	
	Examiner	Art Unit	
	Joanne Silbermann	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,8,9,12-15,21,29,34,36,39-43 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,29,34,36 and 39-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,12-14 and 21 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species 1 in the reply filed on 11 August 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 8, 9, 34, 36, and 39-43 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11 August 2006.
3. Claim 29 stands withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Objections

4. Claim 15 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 112

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5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13 and 21 each recite "further comprising like ornaments strung together with other ornaments" which is previously claimed in both claims 1 and 12, from which claims 13 and 21 depend. Such language appears to suggest there are additional strings of ornaments, in which case these should be distinguished from those previously claimed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 2, 4, 6, 12 and 21, as far as definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. US #5,743,616 in view of Volland, US #4,965,701.

9. Giuliano et al. teach an ornament comprising body panel 10 made of plastic having sides and an etched surface, 10a, with a design, 12 (Figures 1 and 2). This design may be any non-random image (column 2 line 22). Opening 11 in one side of

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the body holds light emitting diode 1 by means of transparent material 2. A plurality of light sources may be used. The body panels may be colored and may include a mirrored surface.

10. The display of Giuliano et al. is decorative in that it is described as “design art” (column 1 line 45) and “an art rendering” (column 2 line 21). The artwork or rendering is considered to be a symbol and may be for a holiday or Christmas.

11. Giuliano et al. do not teach the specific method by which the article is made, however the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

12. Giuliano et al. do not teach a string of ornaments, however Volland teaches string 14 of ornaments 15. The ornaments can be different sizes or shapes (Figure 6). As shown in Figure 7, like ornaments are strung together. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to utilize a string of ornaments (as taught by Volland) to provide a larger, more aesthetically pleasing display.

13. Regarding claim 6, Giuliano et al. do not teach the specific materials recited in the claim, however it would have been obvious to one having ordinary skill in the art to utilize such materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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14. Claim 13, as far as definite, is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Voland as applied to claims 1 and 12 above, and further in view of Ming-ho, US #5,217,286.

15. Giuliano et al. do not specifically teach a Christmas ornament, etc. however Ming-ho teaches a variety of ornaments and structures, as discussed in column 14 lines 37-53. It would have been obvious to one of ordinary skill in the art to utilize any well-known shape or ornament to serve the user's particular purpose. Additionally, matters relating to ornamentation only, and having no mechanical function, cannot be relied on where claims are not directed to design but are structural claims. In re SEID, 73 USPQ 431 (CCPA 1947).

16. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giuliano et al. and Voland as applied to claim 12 above, and further in view of Dimmick, US #5,151,679.

17. Giuliano et al. and Voland do not teach the secondary light scattering elements as being shavings or bubbles, however this is well known in the art as taught by Dimmick. Dimmick teaches an illuminated sign including light scattering means comprising bubbles (column 4 lines 67-68). It would have been obvious to one of ordinary skill in the art to utilize bubbles as a light scattering means (as shown by Dimmick) to provide additional, increased illumination for the display.

Response to Arguments

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18. Applicant's arguments filed 29 March 2006 have been fully considered but they are not persuasive.

19. *Applicant's request for assistance in choosing which claims to elect*

20. Applicant's request for assistance has been received, however, the examiner is not permitted to make such an election. Applicant cites MPEP 707.07(j) however this refers to claims that have been indicated as allowable. No claims have yet been indicated allowable. Applicant also cites MPEP 713.01, however since no claims have been indicated allowable, the examiner cannot suggest which species would be patentable.

21. *Response to election requirement*

22. Regarding Applicant's election of Species 1, Applicant has stated that claims 1-7 and 12-33 correspond to the elected Species. However, claims 3, 5, 7, 16-20, 22-28 and 30-33 have been canceled and claim 29 stands withdrawn. Therefore, claims 1, 2, 4, 6, 12-15 and 21 are addressed in the above rejection.

23. *Rejection of claims*

24. Applicant argues that Giuliano et al. do not use the word "ornament" and therefore the display shown by Giuliano et al. cannot anticipate nor render obvious Applicant's invention. However, an ornament is simply something that adorns or decorates, which an illuminated display such as Giuliano et al. clearly does. Applicant also argues that Giuliano et al. do not teach irregular shapes for the panels, however Giuliano et al. (column 3 lines 37-38) discusses "non-flat panel configurations".

25. Applicant argues Giuliano et al. does not teach a string of ornaments, however, as discussed in the above rejection, this is shown by Volland.

26. Applicant argues that the panel of Giuliano et al. is not molded, however, as discussed above, method limitations are not accorded patentable weight in article claims.

27. Applicant argues that the designs recited in claim 13 do not have a specific shape. However, whether the shapes (heart, crescent moon, etc.) are specific or not, such shapes do not provide a mechanical function, as discussed above, and are not given patentable weight in the instant claims.

28. Applicant argues that Volland does not teach lighting elements made from a single body molded with an LED, etc. however, these claims were rejected by a combination of Giuliano et al. and Volland. Together, these references meet the limitations of the claims.

29. Applicant argues that Volland is non-analogous art, however both Volland and Giuliano et al. teach decorative displays.

30. Applicant argues that Dimmick is non-analogous art. Dimmick teaches an illuminated display, which is considered to be analogous.

31. Applicant argues claim 33, however this claim has been canceled.

32. Applicant argues claims 40 and 41, however these claims were not elected.

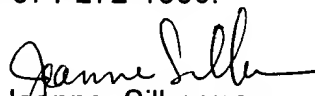
33. Applicant argues that Ming-ho does not provide any ornaments other than stars, however several different ornaments can be seen in the drawings and many more are suggested in column 14 lines 37-53.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joanne Silbermann whose telephone number is 571-272-6653. The examiner can normally be reached on M-F 5:30 - 2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joanne Silbermann
Primary Examiner
Art Unit 3611

js
13 September 2006